

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/159, 509 09/23/98 BROWNING

D 5181-11401

TM02/0410

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EXAMINER

TREAT, W

ART UNIT PAPER NUMBER

2183

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/159,509 Examiner W. TREAT	Applicant(s) Brownning et al. Group Art Unit 2163
<i>—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3 (three)</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication . - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). 		
Status		
<p><input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>2/21/01</u></p> <p><input checked="" type="checkbox"/> This action is FINAL.</p> <p><input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 1 1; 453 O.G. 213.</p>		
Disposition of Claims		
<p><input checked="" type="checkbox"/> Claim(s) <u>1 - 46, 48-94, and 97 - 108</u> is/are pending in the application.</p> <p>Of the above claim(s) _____ is/are withdrawn from consideration.</p>		
<p><input type="checkbox"/> Claim(s) _____ is/are allowed.</p>		
<p><input checked="" type="checkbox"/> Claim(s) <u>1 - 46, 48-94, and 97 - 108</u> is/are rejected.</p>		
<p><input type="checkbox"/> Claim(s) _____ is/are objected to.</p>		
<p><input type="checkbox"/> Claim(s) _____ are subject to restriction or election requirement.</p>		
Application Papers		
<p><input type="checkbox"/> See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.</p>		
<p><input type="checkbox"/> The proposed drawing correction, filed on _____ is <input type="checkbox"/> approved <input type="checkbox"/> disapproved.</p>		
<p><input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p>		
<p><input type="checkbox"/> The specification is objected to by the Examiner.</p>		
<p><input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
Priority under 35 U.S.C. § 119 (a)-(d)		
<p><input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p>		
<p><input type="checkbox"/> All <input type="checkbox"/> Some* <input type="checkbox"/> None of the CERTIFIED copies of the priority documents have been received.</p>		
<p><input type="checkbox"/> received in Application No. (Series Code/Serial Number) _____.</p>		
<p><input type="checkbox"/> received in this national stage application from the International Bureau (PCT Rule 17.2(a)).</p>		
<p>*Certified copies not received: _____.</p>		
Attachment(s)		
<p><input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ <input type="checkbox"/> Interview Summary, PTO-413</p>		
<p><input type="checkbox"/> Notice of Reference(s) Cited, PTO-892 <input type="checkbox"/> Notice of Informal Patent Application, PTO-152</p>		
<p><input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948 <input type="checkbox"/> Other _____</p>		
Office Action Summary		

Art Unit:

1. Claims 10-46, 48-94, and 97-108 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

2. The reasons for rejecting applicants' claims as recapture, presented in the previous action continue and are hereby incorporated by reference.

3. Applicants are correct that their original claims could be recovered, in the absence of an art rejection, even though their new claims failed because of

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recapture. However, in the absence of a substantive error their reissue oath would be defective, and their only option would be to abandon the reissue application and request return of the original patent.

4. Applicants' amendments have failed to overcome the recapture rejection in that material limitations of the original claims continue to be left out of the new claims thereby improperly broadening the scope of applicants' coverage.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication should be directed to William M. Treat at telephone number (703) 305-9699.

A handwritten signature consisting of stylized initials "W.M." followed by a surname.

WILLIAM M. TREAT
PRIMARY EXAMINER